

REMARKS

The Office Action mailed May 13, 2010, has been received and reviewed. Claims 1-17 and 29-36 are currently pending in the application. Claims 34-36 are allowed. Claims 1-17 and 29-33 stand rejected. Applicant has amended claims 1-13, 17 and 29-33, and respectfully requests reconsideration of the application as presented herein. Support for Applicant's claim amendments is found in at least paragraph [0041] of Applicant's as-filed specification. No new matter has been added.

Claim Objections

Claims 1, 6, 17, 29 are objected to because of informalities. Specifically, the Office Action states:

Regarding claim 1, the clause "**adequate to handle**" in lines 9-10 is not a positive recitation. One of ordinary skill in the art may ask, under what condition or when a second data rate is adequate to handle the portion (of what)? Or under what condition or when second data rate is not adequate to handle the **portion of what**? Beside the clause "supporting a second data adequate to handle **the portion**" **is an incomplete sentence, some words are missing after the word "portion"**. One of ordinary skill in the art may ask to handle the portion of what??

Regarding claims 6, 17, and 29, the claims have the same discrepancies as in claim 1. (Office Action, p. 2; bold emphasis added).

Regarding the objection to Applicant's claim element of "**adequate to handle**", Applicant respectfully notes that "adequate to handle" is in fact a positive recitation. Specifically, "adequate" defines a discernable condition or boundary that is required for the condition to be met as any performance that fails to be sufficient for "adequate" would result in a discernable failure of the condition. Accordingly, the phrase "adequate to handle" provides the same boundaries as similar phrasology of "sufficient to service" or other likewise discernable conditions.

Regarding the objection to Applicant's claim element of "**portion**" being objected to and the allegation of "portion of what", Applicant's claims 1, 6, 17 and 29 recite, *inter alia*, "a data rate at least a portion greater than a first data rate" which clearly recites the "portion" as being a

data rate portion. Accordingly, the phrase “the portion” is not a portion of an incomplete sentence as alleged.

Applicant has clarified through explanation and respectfully requests the objections to independent claims 1, 6, 17 and 29 be withdrawn.

35 U.S.C. § 112 Claim Rejections

Claims 1, 6, 17 and 29 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection, as hereinafter set forth.

It is well settled that if the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention and if the language is as precise as the subject matter permits, the claims are definite under Section 112, second paragraph. Thus, the essential inquiry pertaining to the requirement for claim clarity as derived from the case law is whether the claims set out and circumscribe the subject matter with a reasonable degree of particularity. Definiteness of claim language must be analyzed not in a vacuum, but in light of such elements as (1) the content of the particular application disclosure, (2) the claim interpretation that would be given by one of ordinary skill in the pertinent art at the time the invention was made, and (3) the teachings of the prior art.

The Office Action alleges:

Regarding claim 1, the claim subject matter “at least a portion greater than a first data rate ...,” is very ambiguous. One of ordinary skill in the art does not know what or which “at least **a portion**” refers to. Which “portion” is which? (Office Action, p. 2; underline emphasis added)

Applicant respectfully disagrees. A clear reading of the claim clearly recites “a portion” that is then compared through the operator (“greater than”) with “a first data rate.” Accordingly, a comparison would require that “a portion” and “a first data rate” exhibit a comparable similarity. Therefore, “a portion” is also a data rate.

The Office Action further alleges:

Claim 1 recites the limitation “the portion of communications” in line 8. There is insufficient antecedent basis for this limitation in the claims. (Office Action, p. 3)

Applicant respectfully disagrees. A clear reading of the claim clearly recites “the portion of communications” that finds antecedent basis in the claim at “a data rate at least a portion greater than a first data rate.”

Applicant respectfully submits that the plain language of the claim as interpreted in view of the specification and the above-recited explanation presents the claim elements in definite and non-ambiguous form. Applicant therefore, respectfully requests reconsideration of claims 1, 6, 17 and 29.

35 U.S.C. § 103 Obviousness Rejections

Obviousness Rejection Based on U.S. Pat. No. 6,901,062, U.S. Pat. No. 6,870,824 and U.S. Pat. No. 5,781,583.

Claims 1-4, 6-12, 17 and 29-32 were rejected as being unpatentable over U.S. Patent No. 6,901,062 to Scherzer *et al* (“Scherzer”) in view of U.S. Patent No. 6,870,824 to Kim *et al* (“Kim”) and further in view of U.S. Patent No. 5,781,583 to Bruckert *et al*. (“Bruckert”). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, “[a] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art . . . it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be

used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-4, 6-12, 17 and 29-32 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

Applicant respectfully asserts that Applicant's amended independent claims 1, 6, 17 and 29, each recite, *inter alia*, "***assign[ing] a lesser number of a plurality of orthogonal codes for supplemental traffic channels*** to one of the groups ***than a number of traffic channels*** to be assigned to the subscriber stations in the one of the groups."

The Office Action concedes:

Scherzer et al. do not disclose explicitly plurality of orthogonal codes for supplemental traffic channels (Office Action, p. 4).

Applicant agrees.

The Office Action then alleges:

Kim et al. ... teach plurality of orthogonal codes for supplemental traffic channels (col 8, lines 37-54) (Office Action, p. 5).

While Kim may teach of "supplemental traffic channels", the citation to Kim at column 8, lines 37-54 clearly teaches away from Applicant's invention as claimed. Specifically, Kim teaches:

[T]he supplemental channel generator 532 spreads the supplemental channel signal with the unique PN code assigned to the mobile station. Here, the fundamental channel and the supplemental channel become the traffic channel. (Kim, col. 8, lns. 50-54).

Clearly, Kim teaches a 'one-to-one' relationship between the fundamental traffic channel and the supplemental traffic channel. Such a teaching in Kim is in distinct contradiction to Applicant's invention as presently claimed in amended independent claims 1, 6, 17 and 29 which respectively recite, *inter alia*, "***assign[ing] a lesser number of a plurality of orthogonal codes for supplemental traffic channels*** to one of the groups ***than a number of traffic channels*** to be assigned to the subscriber stations in the one of the groups."

The Office Action then introduces Bruckert as allegedly teaching “determining whether to spread at least the portion of communications to said [] one of the subscriber stations with one of the orthogonal codes supporting a second data rate adequate to handle the portion” (Office Action, p. 6). Regardless of the veracity of the alleged teachings of Bruckert, none of the cited references, either individually or in any proper combination, teach or suggest Applicant’s claimed element of “*assign[ing] a lesser number of a plurality of orthogonal codes for supplemental traffic channels* to one of the groups *than a number of traffic channels* to be assigned to the subscriber stations in the one of the groups” as recited in Applicant’s amended independent claims 1, 6, 17 and 29.

Therefore, since neither Scherzer nor Kim nor Bruckert teach Applicant’s claimed invention including “*assign[ing] a lesser number of a plurality of orthogonal codes for supplemental traffic channels* to one of the groups *than a number of traffic channels* to be assigned to the subscriber stations in the one of the groups”, these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in amended independent claims 1, 6, 17 and 29. Accordingly, Applicant respectfully requests the rejection of amended independent claims 1, 6, 17 and 29 be withdrawn.

The nonobviousness of independent claims 1, 6 and 29 precludes a rejection of claims 2-4, 7-12 and 30-32 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 6 and 29 and claims 2-4, 7-12 and 30-32 which respectively depend therefrom.

Obviousness Rejection Based on Scherzer, Kim, Bruckert and U.S. Pat. No. 6,424,631.

Claims 5, 13-16 and 33 were rejected as being unpatentable over Scherzer in view of Kim and Bruckert and further in view of U.S. Patent No. 6,424,631 to Czaja *et al.* (“Czaja”). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claims 1, 6 and 29 precludes a rejection of claims 5,

13-16 and 33 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 6 and 29 and claims 5, 13-16 and 33 which respectively depend therefrom.

Allowed Claims 34-36

Claims 34-36 are allowed. Applicant acknowledges this indication with appreciation.

CONCLUSION

Claims 1-17 and 29-36 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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